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09/582,371	11/09/2000	Mark Sheridan Westlake	RCA88858	4289

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EXAMINER

VU, NGOC K

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/582,371

Applicant(s)

WESTLAKE ET AL.

Examiner

Ngoc K. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-13 and 17 is/are rejected.
- 7) ☒ Claim(s) 6-8 and 14-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/23/00.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the limitation "each of the program identifiers" in line 5 is same as "identifiers" in menu defined in line 2 of claims 6 and 14. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 9-12 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyer et al. (U.S. 200200264996 A1).

Regarding **claim 1**, Boyer discloses a method of linking terms (titles) in an electronic message (reminder) to program information in an EPG, the method comprising the steps of:

receiving an electronic message (reminder 810 – see figure 2);

comparing terms in the electronic message to terms in the program information of the EPG (for example, if the user does not enter the exact title(s) of the television programs in

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reminder screen 810, the data of program listings 220 or any other suitable set of television program listings data may be scanned to find the programs that most closely match the program title(s) indicated by the user. That is, the receiver 50 compares the title(s) entered by the user in the reminder to the titles in the program listings data 220 in EPG - see page 4, 0056 and figures 1-2);

displaying the electronic message so that any terms in the electronic message which have a match in the program information based on the step of comparing terms, are distinguishable from terms which have no such match (displaying in the reminder a list of titles that most closely matches based on the step of comparing titles, the user may choose the actual title(s) or the closest matched title(s). That is, the list of title including the title(s) have a match are distinguishable from the title(s) which have no match by the user – see page 4, 0056).

Regarding **claim 2**, Boyer discloses establishing e-mail reminder message including reminding the broadcast of the selected title(s) or the closest matched title(s) (see figure 8 and page 4, 0055).

Regarding **claim 3**, Boyer discloses establishing e-mail reminder message is performed so that selection of the title(s) with a match by the user (e.g., the actual title(s) or the closest matched title(s) selected by the user) effects implementation of a respective program which is defined by the program information having the match (e.g., reminding the broadcast of the program having the actual title(s) or the closest matched title(s) – see figure 12 and page 4, 0055).

Regarding **claim 4**, Boyer shows displaying an electronically generated menu of choices (e.g., 830 and 824 – in figure 8) in response to user selection of the closest matched title(s), each of the choices being selected by the user to effect an action described by each choice (for

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example, if the user selects the "1 hour" option in choice 830 and the "each time this week" option in choice 824, the user will receives five e-mail reminder messages 1 hour before each broadcast of the program during that week (see figure 8; page 4, 0058 and pages 3-4, 0048 and 0049).

Regarding **claim 9**, Boyer discloses a electronic message interface adapted to link terms (titles) in an electronic message (reminder) to program information in an EPG, the electronic message interface comprising:

a receiver adapted to receive an electronic message (e.g., receiver 50 receives reminder 810 – see figures 1-2);

comparison unit (within receiver 50) adapted to compare terms in the electronic message to terms in the program information of the EPG (for example, if the user does not enter the exact title(s) of the television programs in reminder screen 810, the data of program listings 220 or any other suitable set of television program listings data may be scanned to find the programs that most closely match the program title(s) indicated by the user. That is, the receiver 50 compares the title(s) entered by the user in the reminder to the titles in the program listings data 220 in EPG - see page 4, 0056 and figures 1-2);

a display device (54) adapted to display the electronic message so that any terms in the electronic message which have a match in the program information based on the step of comparing terms, are distinguishable from terms which have no such match (displaying in the reminder a list of titles that most closely matches based on the step of comparing titles, the user may choose the actual title(s) or the closest matched title(s). That is, the list of title including the title(s) have a match are distinguishable from the title(s) which have no match by the user – see page 4, 0056 and figure 1).

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Regarding **claim 10**, Boyer discloses establishing e-mail reminder message including reminding the broadcast of the selected title(s) or the closest matched title(s) (see figure 8 and page 4, 0055).

Regarding **claim 11**, Boyer discloses a selector (within receiver 50) adapted to select the actual title(s) or the closet matched title(s) selected by the user, via the e-mail reminder message, implementation of a respective program which is defined by the program information having the match (e.g., reminding the broadcast of the program having the actual title(s) or closest matched title(s) – see figure 12 and page 4, 0055).

Regarding **claim 12**, Boyer shows displaying on the display device (54) an electronically generated menu of choices (e.g., 830 and 824 – in figure 8) in response to user selection of the closest matched title(s), each of the choices being selected by the user to effect an action described by each choice (for example, if the user selects the “1 hour” option in choice 830 and the “each time this week” option in choice 824, the user will receives five e-mail reminder messages 1 hour before each broadcast of the program during that week (see figures 1 and 8; page 4, 0058 and pages 3-4, 0048 and 0049).

Regarding **claim 17**, Boyer shows that the display device is a television (see figure 1).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al. (U.S. 200200264996 A1) in view of Hirata (US 6,374,406 B2).

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Regarding **claims 5 and 15**, Boyer teaches sending email reminder message to remind the broadcast of the selected program(s) by the user. The email reminder message shows the program information of the selected program(s) (see abstract and figure 12). Boyer does not teach the email reminder message including the feature of recording the program. However, Hirata teaches that an email message comprises a control command, for example, "video reservation" in Subject of the email message. This suggests that the email includes a control command to reserve a recording of a program or channel (see col. 5, lines 42-50 and figure 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the email reminder message of Boyer by including recording command in the email message to reserve a recording of a program or channel as taught by Hirata in order remotely control recording the selected program or channel via email with less operation cost.

***Allowable Subject Matter***

6. Claims 6 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Claims 7, 8, 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu  
Examiner  
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November 8, 2004